

# SUPREME COURT OF THE UNITED STATES

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OCTOBER TERM, A. D. 1897.

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McCORMICK HARVESTING MACHINE COMPANY,  
*Appellant,* }  
vs. } No. 130.  
C. AULTMAN & COMPANY ET AL.,  
*Appellees.* }

AND

McCORMICK HARVESTING MACHINE COMPANY,  
*Appellant,* }  
vs. } No. 131.  
AULTMAN-MILLER COMPANY,  
*Appellee.* }

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## BRIEF OF ARGUMENT FOR APPELLEE.

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*May it please the Court:*

These cases come up on a certificate from the United States Circuit Court of Appeals for the Sixth Circuit. They involve a single question of law that has never yet been decided by this court.

The actions in the courts below were suits in equity to restrain the infringement of letters patent No. 159,506, issued February 9, 1875, to Marquis L. Gorham, for

Improvements in Automatic Grain Binders. The defendants were charged with infringing, among others,<sup>3</sup> the third, tenth and eleventh claims of the patent.

It appeared in the proofs that in 1881 the owner of the Gorham patent applied for a reissue of the patent, including in the application for the reissue many new claims and many of the old claims of the patent, including the third, tenth and eleventh claims—the ones, among others, in respect to which infringement was charged. The Examiner held that some of the old claims and some of the new claims should be allowed, but *rejected* the third, tenth and eleventh claims, among others, for *want of patentable novelty*. No appeal was taken, although the case was pending in the Office for nearly two years. The reissue application was abandoned, and the original patent, on request, was returned to the owner. After the return of the patent, suit was commenced on the third, tenth and eleventh claims, among others, which had been rejected *on their merits* for want of patentable novelty and on reference to prior patents.

In the Circuit Court Judge Jackson held that the third, tenth and eleventh claim of the patent were invalidated and no longer in force because of their rejection and the acquiescence of the owner of the patent therein without appeal. He accordingly dismissed the bills.

On appeal to the United States Circuit Court of Appeals for the Sixth Circuit, the court were in doubt as to the effect that should be given to the rejection on the merits and acquiescence in such rejection on the application for reissue, and certified up to this court the following question:

“If the owner of a patent applies to the Patent Office for a reissue of it and includes, among the claims in the application, the same claims as those which were included in the old patent, and the Primary Examiner rejects some of such claims for want of patentable novelty, by reference to prior patents, and allows others, both old and new, does the owner of the patent, by taking no appeal and by abandoning his application for reissue, hold the original patent (the return of which he procures from the Patent Office) invalidated as to those of its claims which were disallowed for want of patentable novelty by the primary examiner in the proceeding for reissue?”

The question above presents for determination the status of those original claims in a patent which are rejected on their *merits* and for want of patentable novelty on an application to reissue the patent. The question assumes that the rejection was right—that the claims were met. This question, as before said, has never been determined by this court.

Sec. 4916 of the Revised Statutes, which provides for the surrender and reissue of inoperative or invalid patents, says that:

“The Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued . . . such surrender shall take effect upon the issue of the amended patent. . . . The specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are.”

This court has twice had occasion to refer to this section of the statute, and has on each occasion reserved from

decision the question now under consideration, although employing language implying, as we think, that where original claims are rejected *on their merits*, as for want of novelty, the rejection would be fatal to such claims. We will quote from these decisions, so that the exact language of the court will be presented for convenient consideration.

In *Peck v. Collins*, 103 U. S., 665, the court, through Mr. Justice Bradley, in considering a patent that had been surrendered before the Act of 1870, said:

“ Since the surrender of the patent in this case the patent laws have undergone a general revision by the act of July 8, 1870, c. 230. In the fifty-third section of that act (being the section relating to the surrender and and reissue of patents), a new clause was introduced, declaring that the surrender ‘ shall take effect upon the issue of the amended patent;’ and this clause is retained in sect. 4916 of the Revised Statutes. What may be the effect of this provision in cases where a reissue is refused it is not necessary now to decide. Possibly it may be to enable the applicant to have a return of his original patent if a re-issue is refused on some formal or other ground which does not affect his original claim. But if his title to the invention is disputed and adjudged against him, it would still seem that the effect of such a decision should be as fatal to his original patent as to his right to a reissue.”

In *Allen v. Culp*, 166 U. S., 505, the court, through Mr. Justice Brown, in a case where the Examiner refused the reissue upon the ground of unreasonable delay and because the *new* claims were substantially anticipated—the decision of the Examiner not touching the *original* claims—said:

“ If the original application for a reissue be rejected, the original patent stands precisely as though a reissue had never been applied for, unless at least

the reissue be refused upon some ground equally affecting the original patent."

This language recognizes that the rejection may be upon grounds which *do* affect the original patent—"equally affecting the original patent."

In the case now under consideration, the question is squarely presented for determination, whether the rejection of the *old* claims on their merits in reissue proceedings and the acquiescence in such rejection by the applicant invalidates such *old* claims. The question is based on the assumption that the rejection was right and that it was a mistake to have allowed the claims in the first instance. A decision of this question in the negative must operate as a holding that old claims, even though *exactly* met in prior references which had been overlooked on the original examination, can still be saved by a sharp applicant—by abandoning the reissue proceedings and withdrawing the patent. A decision of this question in the negative will be tantamount to a nullification of the provision in the statute that the specification and claims in a reissue application "shall be subject to revision and restriction in the same manner as original applications are," by putting it in the power of the applicant to abandon his reissue application, withdraw the original patent, and set at naught the judgment of the tribunal he had invoked in the hope of securing advantage.

Judge Jackson, whose decision was announced after he had been elevated to this court, in discussing the effect of the reissue proceedings now under consideration and in deciding the case on the circuit, in 58 Fed. Rep., 778, said:

"It is shown by the record that the owners of the

Gorham patent, in 1881, before its transfer and assignment to the complainant, filed an application in the patent office for a reissue thereof, which contained claims substantially, if not identically, the same as said original claims here involved, together with other claims which sought to broaden and enlarge the scope and bearing of said original claims. In acting upon this application the Patent Office not only denied the broader claims sought to be secured, but rejected the claims which were either a literal or substantial repetition of said claims 3, 10, 11, 25 and 26 of the original patent, on which the present suit is based. This rejection was rested or predicated by the examiner on reference to various prior patents. The owner of the Gorham patent took no appeal from this decision or adverse action of the patent office, but acquiesced in the same, and thereafter requested and obtained a return of the original letters patent; leaving the decision of the examiner, rejecting both said original claims, and the new claims presented to broaden the same, in full force and operation.

Now, what is the legal effect of this proceeding, and of the adverse action or decision of the department thereunder, upon said claims 3, 10, 11, 25 and 26? In withdrawing or securing a return of the original letters patent after an adverse decision by the patent office on said claims, is the patentee, or his successor in right and interest, entitled to assert the validity of said claims or insist upon the benefit thereof, unaffected by the reissue proceedings and such adverse action? We think not. It is well settled that the rejection of such claims on an original application, and acquiescence in such rejection, would conclude the patentee in respect thereto. *Sutter v. Robinson*, 119 U. S., 541, 7 Sup. Ct. Rep., 376; *Shepard v. Carrigan*, 116 U. S., 597, 6 Sup. Ct. Rep., 493. The same principle should apply in a case like the present, where a party voluntarily resubmits his patent to the examination and revision of the patent office, and acquiesces in a rejection of certain claims thereof, or in a construction placed thereon which operates to restrict or narrow the

patent. There is no distinction, in principle, between an acquiescence in an adverse decision in order to secure a patent in the first instance, and a like acquiescence in the rejection of claims reopened and resubmitted to the jurisdiction of the patent office under reissue applications. In each case the patentee is entitled to only what the office allows. By section 8 of the patent act of 1837, it was provided that, whenever a patent should be returned for reissue, the claims thereof should be subject to revision and restriction in the same manner as were original applications for patents. This provision was substantially repeated in section 53 of the patent act of 1870, which is re-enacted in section 4916, Rev. St. While it is provided by this section that 'the surrender shall take effect upon the issue of the amended patent,' it is also further provided that on application for reissue 'the specification and claim, in every such case, shall be subject to revision and restriction in the same manner as original applications are.' These two provisions of said section were under consideration in *Peck v. Collins*, 103 U. S., 665, and in respect to the former the supreme court left open the question whether, in cases where a reissue is refused on some formal or other ground which did not affect the original claim, an applicant could have a return to his original patent, while, in respect to the latter provision, making the specifications and claims subject to revision and restriction in the same manner as original applications, the court said:

" 'But if his (the patentee's) title to the invention is disputed, and adjudged against him, it would still seem that the effect of such a decision should be as fatal to his original patent as to his right to a reissue.'

" 'The original claims 3, 10, 11, 25 and 26, having been voluntarily resubmitted to the revising jurisdiction of the patent office by the application for reissue, which repeated them literally or in substance, and having been rejected or adjudged against the patentee, not on formal grounds, but for reasons and on reference to prior patented devices which went to his right and title to such claims, and no

appeal having been prosecuted from that decision, as the applicant could have done under sections 4909-4911, etc. of the Revised Statutes, the effect of such adverse decision by the patent office should be regarded as fatal to said claims, to the same extent as their rejection upon the original application would have been. If, as seems clear, the reissue application placed these claims within the jurisdiction and power of the patent office to revise or restrict, and the office, while possessed and in the exercise of such jurisdiction, decided against the patentee's right and title to such claims, he had two courses open to him: He could seek a reversal of the examiner's action, or acquiesce in the rejection. If he elected the latter course, and took back the original letters patent, with such adverse decision remaining in force, his action, in legal effect, operated to exclude the rejected claims as parts of the patent. The return of the letters patent, under such circumstances, could not restore validity to said claims, or reinstate them to the same position or status they occupied before the reissue application was filed. The withdrawal of the letters patent after adverse action on the claims presented should be treated as an amendment thereof, to the extent of the original claims rejected. The language of the statute conferring jurisdiction upon the patent office to revise and restrict the claims presented in such cases; the decisions of the supreme court upon the effect of acquiescence on the part of the applicants in adverse decisions and rulings of the patent office: sound principle and good policy,—support this view of the subject. Patentees should not be allowed to experiment and take chances in attempts either to secure reissues, or to extend, enlarge, or broaden their inventions, without taking the risk, and subjecting themselves to the same rules and principles which apply and govern in original applications. Our conclusion is that the adverse action of the department upon said claims, with the patentee's acquiescence therein, operated to invalidate the same. But if said claims survived the revisory action and rejection thereof by the patent office un-



der the reissue application, still the unsuccessful attempt made in that proceeding to broaden or expand said claims must, upon well-settled principles, be held to so limit and restrict their construction as to exclude what was thus rejected, and to confine them to the specific devices and combinations therein described."

In this review of the decisions—two by this court containing intimations and reserving the question, one by Judge Jackson deciding the question in the affirmative, and one by the Circuit Court of Appeals below, in which a diversity of opinion evidently obtained—it becomes important to consider, as we conceive, three substantive matters—the *extent* of the *jurisdiction* acquired by the Patent Office on an application for a reissue; the *effect* of the *action* of the Patent Office on such application; and the *nature* of the *remedy* provided for adverse action by the Patent Office.

Under the express language of the statute, and under the express decision of this court in *Allen v. Culp, supra*, no surrender of the original patent takes place on the mere application for a reissue of it. "Such surrender shall take effect upon the issue of the amended patent." When, therefore, the application was made for the reissue of the Gorham patent there was no technical surrender of it. There was, however, a *reinvestment* of the Patent Office with *jurisdiction* over the original patent and its original claims, the same as over the new matter and new claims introduced on the application for a reissue. There was a voluntary *resubmission* of the entire matter to the jurisdiction of the Patent Office.

Section 4916 of the Revised Statutes, providing that a

party whose patent is inoperative or invalid may apply for a reissue of the same, says that "the specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are."

This language obviously was intended to give the Office plenary and effective *jurisdiction* over the entire subject-matter, when a party voluntarily brought his patent back and asked to have it reissued. In *every* such case the specification and claims shall be *subject to revision and restriction* in the *same* manner as *original* applications are. The language could not well have been broader. The right to revise and restrict is expressly given to the Office. There was an object in this. It was to enable the Office to review its former action and to correct mistakes. The right to a reissue *presupposes* mistakes which ought to be corrected. When the applicant represents that there are mistakes and asks to have them corrected, the Office on its part may *also* suggest and insist upon the correction of mistakes. The Office is not limited by the statute *simply* to the mistakes which the applicant points out and asks to have corrected. It is given the right to *revise* and *restrict* to the same plenary extent that it had *originally* when the application was first presented.

The nature and extent of the jurisdiction and powers of the Office in the case of original applications are well known. It may *reject* claims because anticipated by prior patents. Under the statute the same extent of power is given to the Office in reissue applications. When a patent is issued and delivered to an applicant, the Office has no further jurisdiction over it, except in interference proceedings under section 4904, Revised Statutes, unless the

applicant *voluntarily* resubmit himself, and the subject-matter of the invention, to the Office, by filing an application for a reissue. When he does this, however, the Office is again clothed with power and given the right, under the statute, to consider whether the patent ought originally to have been allowed.

The statute provides what the patentee must do to obtain a reissue of his patent. A careful reading of the statute shows that the duty of the Office, in the first instance, is to determine whether a mistake or error occurred in the original issue, and if so, whether the circumstances are such as to entitle the party to a correction of the mistake by way of a reissue of the patent; but the power of the tribunal does not end here. It may of its own accord open up the original *ex parte* case between the patentee and the public, and decide upon the original patent and revise and reverse its original rulings. In the case of the Gorham reissue application the Office decided that it was a proper case for such action. The counsel for the appellants speaks of the proceedings as the preliminary correspondence between the patentee and the Office. The proceedings under the application cannot be belittled in this manner or their effect thus avoided. It was a proceeding before a tribunal vested with great powers in hearing *ex parte* cases. The application for reissue in this case was of a most extraordinary character. As appears by the opinion and findings of the court, many new claims were introduced and the scope of the patent intended to be greatly enlarged. It will not do to say that the application for a reissue was an ill-advised action of a person ignorant of her rights, advised by a patent solicitor without legal learning, and that, when the patentee's rights had been

transferred to the present claimant, wiser counsel prevailed. We regret that the application was not certified up by the court. But an examination of the record and a reading of the opinion of Judge Jackson will show the fallacy of this pretence. The application for a reissue was in fact a cunningly contrived attempt, devised by astute attorneys, cleverly framed and artfully prepared, for the purpose of absorbing inventions in the special field to which it related which had not been presented or claimed originally. The original patent was enlarged, broadened in essential parts, and many claims, never thought of at the time of the original application and until the art had been developed, injected for the purpose of enlarging the boundaries of the patentee's monopoly far beyond its original limits. The extraordinary character of the application could not fail to excite the attention of the Office, and, by virtue of the powers vested in it, it exercised the jurisdiction clearly conferred upon it to open up the original case and challenge the validity, not only of the new claims, but of all of the old claims upon which recovery was sought to be had in the court below. The only question that remains to be considered is whether in this situation of the case the parties interested in the patent had the power to paralyze the jurisdiction of the court and terminate the proceedings by abandoning the reissue proceedings and withdrawing the original patent after a decision against them on the merits.

Every applicant for a reissue voluntarily assumes the risk of having the Office reverse its judgment and reject what it previously allowed. He runs no risk of losing his patent by a rejection on mere *formal* grounds, that do not go to the merits, as was admitted in *Peck v. Collins*

and *Allen v. Culp, supra*, but he does run the risk of losing his patent where the Office on a further investigation finds that the subject-matter of it is *met* on its merits and *anticipated* by prior patents. As long as he remains out of the Office his patent cannot be affected by the Office, except in interference proceedings; but when he *voluntarily* returns and *reinvests* the Office with jurisdiction, he must abide the consequences. Otherwise, the Office might find—as in the case under consideration—that prior patents anticipated the claims and divested them of patentable novelty, and their finding be a mere *fulmen brutum*. They might find a prior patent for the same thing, with the drawings, description and claims corresponding line for line and word for word with the drawings, description and claims of the original patent surrendered to be reissued, and yet be compelled to allow applicant, upon his withdrawing his application for a reissue, to go forth with his patent to impose upon the public who may never learn of the reissue proceedings *because they are secret*, or hear of the reference, which may be some foreign patent or publication not readily accessible to the public. To prevent this, therefore, the statute evidently intended to give the Office plenary power to act and to make its action *effective* when it discovered that its prior action was wrong.

In providing that the surrender should take effect upon the issue of the amended patent the statute evidently had the purpose and intent to keep the patent alive while it was pending in the Office for a reissue. The proceedings for a reissue might be pending two or three years. If the surrender took effect immediately upon the filing of the application for a reissue, there would therefore be a *hiatus* in the life of the patent. There would be two or

three years in which there was no patent. By keeping the patent alive this consequence would be avoided. But notwithstanding the continued technical and legal existence of the patent, the statute gave the Office complete *jurisdiction* over its subject-matter, and intended that such jurisdiction should be effective for the correction of any mistakes that might be found. Though there was no technical surrender of the patent, yet there was *jurisdiction* conferred on the part of the Office over its subject-matter—a jurisdiction conferred by the *voluntary* act of the owner of the patent. The important consideration is not whether the patent was technically *surrendered*, but whether the Office had *jurisdiction* over it, *authority* to review, *power* to revise and restrict its previous action. *Jurisdiction* and power to act, not *surrender*, is the important consideration. As the statute provides and as we have seen, such jurisdiction is full and the authority conferred on the Office plenary to take such action as further investigation might render proper. The *extent* of the *jurisdiction* of the Office was made by the statute the same in every respect as it originally had been when the application for the patent was presented in the first instance.

In perfect confidence we submit that after the Office had exercised its jurisdiction of re-examining and rejecting the *original* claims the patentee had no *right* to withdraw the patent, and the act of the Office in surrendering it was *ultra vires* and without authority of law. The case was pending; a decision had been made; that decision was in favor of the people as against the patentee. From that decision no appeal had been taken, and the act of returning the patent by some official in the Office was *ultra vires*. The act of returning was at most merely a *clerical* and not

a judicial action. It involved no decision and could not appear as a reversal of the decision already made and could have no effect upon it. The people, so far as the proceedings had progressed, had obtained a victory, and since then there has been no decision by the only tribunal authorized to reverse such decision.

It may be claimed that the original patent constituted a contract between the patentee and the government. In a sense this is true, but only in the sense that every grant involves a contract. It has been urged that the application for reissue amounted simply to negotiations, preliminary in their character, between the contracting parties looking to the amendment of the contract. This claim is wholly fallacious. As admitted above, every grant from the government to an individual involves, in a certain sense, the element of contract, but it is a contract of peculiar character and subject to conditions of its own. The granting of a corporate franchise involves the element of contract, and we may illustrate our view of the question at hand by a reference to the law of corporations, which seems analogous. In the celebrated Dartmouth College cases it was decided by this court that the granting of a franchise to a private corporation constituted a contract, which, under the Constitution of the United States, could not be impaired by the subsequent act of a state. It is a matter of common history that serious apprehension was excited by this decision by reason of the supposed dangers to public and private interests by application of this doctrine to all corporations, existing and future. But it will be remembered that an associate justice of this court pointed out that, so far as future corporations were concerned, it was quite within the power of the legislatures granting or authorizing fran-

chises thereafter to make them subject to repeal or amendment, and it is well known that since that day almost all the corporate franchises granted for private purposes throughout the United States have been made by their terms subject to repeal or amendment by the granting power. We think the law is not different in the matter of patents. The granting of a patent and its acceptance by the patentee undoubtedly involves the element of a contract, but it is a contract which, under certain circumstances, is subject, like the franchise of a corporation, to repeal or amendment. Not only may the decision of the patent tribunal be opened up before courts of competent jurisdiction, but in the case of an application for reissue the tribunal itself which originally granted the patent has the right, *by virtue of express grant of power* by Congress, to reopen the original question and subject the patent "to revision and restriction in the same manner as original applications are." As under the original application the Office had the power to determine what patents should be issued, and a contract came into being only by the inventor's acceptance of that particular patent, so when the patent was brought back to the same tribunal it became immediately subject to revision and restriction the same as almost every corporate franchise existing at the present time is subject to repeal or amendment whenever the legislature which granted or authorized it sees fit to exercise that power, subject, of course, to the limitations now well established by the courts.

There can be no question, therefore, as it seems to us, that the Office had full *power* to reject the claims of the Gorham patents on their merits, as it did, if found anticipated by prior patents. If this be so, to what conclusion does it lead us ?



The action of the Office when it rejects a claim in a re-issue application is of the same nature as when it rejects a claim on an original application. The statute says that the specification and claims shall be subject to revision and restriction "in the same *manner* as original applications are." Reissue applications are placed on precisely the same footing as original applications. They enjoy no higher *privileges* and are subject to no greater *exemptions*. In an application for a reissue the applicant presents and asks for the consideration and action of the Office on his claims contained in the reissue application. Where he repeats old claims and adds new ones, he does not and cannot ask merely for a consideration of his *new* claims. He submits *all* to the consideration and action of the Office. The Office is not restricted to a consideration of the *new* claims *only*. It is authorized—and in the discharge of its duties it is obligated—to take up and consider and act upon *all* of the claims presented, the *old* as well as the *new*. Nor has the statute drawn any distinction or recognized any difference in the *action* of the Office when acting upon old claims and when acting upon *new*. On the contrary, such action is by express language made the same in both cases.

If the action of the Office is the same when operating upon *old* claims as it is when operating upon new claims, then it is obvious that the same *effect* must be given to its action in the one case as in the other. This court has repeatedly held that where a claim is rejected, and a party acquiesces in such rejection and takes his patent without the claim, he is thereafter forever estopped either from coming back to the Office and securing such claim in a re-issue or insisting, in the courts, upon a construction of existing claims which were given him, which would make

them of equal scope and meaning as the rejected claims. This is so well established, in case of rejection and acquiescence in such rejection of claims, in the prosecution of original applications that we feel that it is wholly unnecessary to cite or quote from many decisions. We, therefore, simply quote from a recent case in which this doctrine is enunciated so as to present the exact language of the court.

In *Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S., 429, this court said:

“The patentee having once presented his claim in that form, and the Patent Office having rejected it, and he having acquiesced in such rejection, he is, under the repeated decisions of this court, now estopped to claim the benefit of his rejected claim or such a construction of his present claim as would be equivalent thereto.”

Not only is a party estopped from insisting that claims rejected by the Office and acquiesced in by him are in *existence* as claims, but he is estopped from insisting that his claims actually existing are the equivalent of the ones rejected. In short, where a claim is rejected in an original application and the applicant acquiesces in such rejection, the matter is wholly and absolutely ended, so far as such claims are concerned. The same effect, in legal contemplation, must follow the rejection of an original claim repeated in a *reissue* application, because the statute has made no *distinction* whatever between them or in the action of the Office upon them.

Nor can it be said that there is a *consideration* for acquiescence in the rejection of claims on an *original* application that does *not* exist for acquiescence in the rejection of original claims on a *reissue* application, or that appli-

cant perhaps acquiesces in the rejection of some of his claims in the former case in order to get a patent for the others, without such motive for his action in the latter, for, as a matter of fact, an applicant for a reissue may acquiesce in the rejection of some of his *original* claims in order to withdraw his patent—get it back—so as to get the benefit of the original claims which the Office has not invalidated or impeached. In the present case it appears, from the statement of the court below and from the statement of the question propounded to this court for decision, that the Examiner *allowed* some claims, “*both old and new.*” When the owner of the Gorham patent, therefore, decided to acquiesce in the rejection of some of his old claims as well as the new, he was *enabled* to get his patent back with the old claims, *some* of which had *not* been affected by the action of the Office. He was willing to acquiesce in the action of the Office in order to get a patent for *some* good claims still remaining in it, just as an applicant in an original application is willing to acquiesce in a rejection of some of the claims in order to get a patent containing the others. In both cases there is precisely the same *consideration* for acquiescence in the rejections of the Office—the getting of a patent with *some* unrejected claims in it. But *acquiescence* is not a necessary element for consideration. A tribunal the virtue of whose decisions depends upon the acquiescence of the suitors who appear before it, must be weak indeed. *Jurisdiction* and *decision* are the main things to be considered.

It seems to us, therefore, that the *effect* of the official action in the rejection of the original claims resubmitted to the Office in an application for a reissue is precisely the same as the action of the Office on original applica-

tions, and should be effectuated by the courts to the same extent.

The nature of the *remedy* provided for the rejection of the claims on reissue applications is the same as that provided for an applicant on original applications. He has a right of *appeal* from the action of the Examiner to the appellate tribunals in the Patent Office, and from the final action of the Office to the courts of equity under Section 4915 of the Revised Statutes. As is well known, an appeal lay from the action of the Primary Examiner rejecting claims to the Board of Examiners-in-Chief, and from the Board of Examiners-in-Chief to the Commissioner in person, and from the Commissioner in person to the Supreme Court of the District of Columbia; and if none of these appellate tribunals give the applicant what he considers that he is entitled to, "the applicant may have remedy by a bill in equity." This court has frequently recognized that a party should resort to his remedies by appeal if he is dissatisfied with the action of the Office in rejecting his claims.

In *Mahn v. Harwood*, 112 U. S., 359, this court said:

"The proper remedy of the patentee when a claim applied for is rejected, is an appeal."

In *Shepard v. Corrigan*, 116 U. S., 598, this court said:

"If dissatisfied with the decision rejecting his application, he should pursue his remedy by appeal."

In the case under consideration no appeal was taken. The applicant for a reissue disregarded the plain remedy proper for the correction of any error, if there were one, in the action of the Office in rejecting original claims 3, 10 and 11, among others, repeated in his application for

a reissue. He *acquiesced* in the decision of the Office, *abandoned* his application for a reissue, took back his original patent and has been insisting in the courts that claims are valid which the Office rejected as invalid, as anticipated, as lacking in patentable novelty. If dissatisfied with the decision of the Office, why did he not appeal? The court says that that is the *proper* remedy. On a decision of the Office against him he goes into the courts and insists that such decision is not binding upon him and has no force or effect. It is as though a party acquiesced in the decision of a court of law when remedies by appeal are provided, and afterwards, in another court, when confronted by such decision, claimed that it amounted to nothing. We are asking that *effect* be given to the decision of the Office. We are relying upon it as a *bar* to the maintenance of this suit—as an estoppel by *record*. Appellant seeks to avoid such decision—attack it *collaterally*. Having ignored his remedy by appeal, he asked the courts, and is asking this court, to review the action of the Office in this *collateral* proceeding and regard it as naught. As well might a patentee who had acquiesced in a rejection of claims on an original application and taken his patent for other claims ask the courts to find that the action of the Office in rejecting his claims was wrong, and to give such effect to his claims allowed as would give him the benefit of his rejected claims. The courts have uniformly refused to do this. They have held that the action of the Office is *conclusive*. They have not attempted to go behind the Office. They have accepted applicant's acquiescence and omission to appeal—to pursue the remedies provided—as conclusive upon him in all proceedings thereafter in the courts and everywhere.

We submit and insist, therefore, that the remedy open to the owner of the Gorham patent, if he was dissatisfied with the action of the Office in rejecting the original claims 3, 10 and 11 on his application for a reissue, was by appeal; that having acquiesced in the action of the Office and failed to avail himself of the remedies provided for such cases, the decision of the Office against him has become absolute and conclusive in all *collateral* proceedings and elsewhere; and that the Gorham patent must be considered precisely the same as if claims 3, 10 and 11 had been *erased* by the Office before returning the original patent, or, as expressed by Judge Jackson, the withdrawal of the letters patent after rejection and without appeal "should be treated as an amendment thereof to the extent of the original claims rejected."

Respectfully submitted,

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